

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Reissue Application of:)
ROGER J. LEYDEN et al.)
U.S. Patent No. 5,552,771) RETRACTABLE SENSOR FOR
Issued September 3, 1996) AN ALARM SYSTEM

REISSUE DECLARATION
PURSUANT TO 37 C.F.R. §§1.172(a), 1.175(a)(1), AND 1.175(a)(3)

Box Patent Application
Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Roger J. Leyden and Terrance J. Surma declare:

1. The residence and country of citizenship of Roger J. Leyden
and Terrance J. Surma are as indicated with their signatures herebelow.

CERTIFICATE OF MAILING BY "EXPRESS MAIL"

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I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Assistant Commissioner for Patents, Box Patent Application, Washington, D.C. 20231.

Nora T. Wesley

(Typed or printed name of person mailing paper or fee)

Nora T. Wesley

(Signature of person mailing paper or fee)

2. We have reviewed and understand the contents of the specification of U.S. Patent No. 5,552,771, including the claims, as amended in this reissue application.

3. We believe that Roger J. Leyden and Terrance J. Surma are the original and first joint inventors of the subject matter which is claimed and for which a reissued patent is sought.

4. We acknowledge the duty to disclose to the Patent and Trademark Office all information known to us to be material to patentability as defined in 37 C.F.R. §1.56.

5. We hereby state under 37 C.F.R. §1.175(a)(1) that we believe that U.S. Patent No. 5,552,771 (hereinafter, "the '771 patent") is partly inoperative or invalid by reason of improperly claiming the invention in claim 11 using language which precisely interpreted is not supported by nor consistent with the disclosure of the invention contained in the application as originally filed.

6. Specifically, we believe that the '771 patent is partly inoperative or invalid by reason of improperly claiming the invention in claim 11 because:

a. The invention as disclosed in the application includes use of a multiconductor cable in which at least two of the conductors of the cable may be electrically connected at the cable end connected to a

product to form a closed loop or electric circuit which is used to indicate to an alarm system that a product is secured to the cable first end.

b. Claim 11 as issued in the '771 patent refers to "maintaining a continuous electrical path from the first end of the cable to the second end of the cable" and to "continuity of the electrical path between the first and second cable ends broken". Precisely interpreted, these recitations of continuity of the electrical path between the cable ends could be interpreted to refer only to continuous conductors extending from the first and second cable ends, independent of whether such multiple cables are connected or disconnected at the first end of the cable to form a loop or closed circuit.

c. Claim 11 as amended in this reissue application more precisely recites the specific structure of the invention as disclosed by referring to an electrical connection between conductors of the cable, that is, by reciting different states with 1) *at least two conductors of the cable electrically connected*, and 2) *said at least two conductors electrically disconnected*, and by further referring to the user breaking the *electric connection of the at least two conductors of the cable.*

7. With respect to the error specified in paragraphs 5 and 6 of this Declaration:

a. Upon information and belief, this error arose due to use of imprecise language regarding the continuous electrical path, and a failure of the attorney prosecuting the application to recognize that the language as presented in the claim issued as claim 11 could be read to indicate that a secured state is provided simply by continuous electric lines extending between the first and second ends of the cable, whereas in fact as disclosed the secured state might or might not be provided when electric lines extend continuously between the first and second ends of the cable, depending upon whether or not the sensor connects those electric lines at the first end of the cable.

b. This error also occurred because the undersigned inventors similarly failed to recognize and appreciate, both when reviewing the application prior to filing in connection with signing the Declaration therefor as well as when assisting the attorney during prosecution, that the coverage of the claims being presented might be read to indicate that a secured state is provided simply by continuous electric lines extending between the first and second ends of the cable.

c. This error continued to go uncorrected until the filing of this reissue application because no one's attention was drawn to this point until shortly before such filing for reissue when the '771 patent was reviewed by the inventors and the assignee's attorney in connection

with their analysis of the patent regarding a potential infringement of the '771 patent. The detailed analysis of the claims preparatory to potential litigation caused this error to be recognized for the first time.

8. We also hereby state under 37 C.F.R. §1.175(a)(3) that we believe that the '771 patent is partly inoperative or invalid by reason of claiming both more than we had a right to claim in the patent and less than we had a right to claim in the patent.

9. Specifically, we believe that the '771 patent in claim 11 claimed more than it had a right to claim because:

a. Claim 11 recites only an assembly including (broadly stated) a housing, a multiconductor cable, retraction means urging the cable into the housing but allowing a first cable end to be pulled from the housing, and means for connecting the second cable end to an alarm system.

b. Prior art, including U.S. Patent Nos. 4,989,805, 5,094,396 and 5,535,960¹ show assemblies including a housing, a multiconductor cable, retraction means urging the cable into the housing but allowing a first cable end to be pulled from the housing, and means

¹Although the filing and issue dates of U.S. Patent No. 5,535,960 to GTE Airfone do not make the patent prior art, the undersigned acknowledge that, insofar as relevant to their patent, the subject matter disclosed in U.S. Patent No. 5,535,960 was in public use prior to the invention of the subject matter of the '771 patent by the undersigned.

for connecting the second cable end to an electrical system. The electrical system with which those prior assemblies are used are telephone systems, and there is no teaching or suggestion of connecting them or in any manner using them with an alarm system. However, since claim 11 does not positively recite an alarm system as a part of the claimed combination, claim 11 might be interpreted in a manner which would be anticipated under 35 U.S.C. §102 by each of U.S. Patent Nos. 4,989,805, 5,094,396 and 5,535,960.

c. Claim 11 as amended in this reissue application more precisely recites the specific structure of the invention which distinguishes from such prior art by positively reciting a sensor attached to the first cable end, attachable to a product, and having two states, 1) secured when attached to the product with at least two conductors of the cable electrically connected and 2) unsecured when detached from the product with said at least two conductors electrically disconnected. This new combination is thus more in accord with the combinations recited in the other issued claims, with a sensor positively recited to positively recite structure relating to the basic environment of the invention (namely, an alarm for protecting against theft or loss of products) and thereby clearly distinguish the invention from only remotely

related prior art such as U.S. Patent Nos. 4,989,805, 5,094,396 and 5,535,960.

10. Specifically, we also believe that the claims of the '771 patent claimed less than it had a right to claim because:

a. No claims recite the following combination of elements:

a housing;

a cable having first and second conductors extending between opposite first and second ends of said cable;

means for attaching said cable first end to a product;

means for electrically connecting said first and second

conductors at said first end of said cable whereby 1)

 said first and second conductors form an alarm loop

 extending from said cable second end through said

 first conductor to said cable first end and back

 through said second conductor to said cable second

 end when said attaching means attach said cable to

 a product and 2) said alarm loop is broken by de-

 taching said cable from a product;

a connector for connecting said cable second end to an alarm system responsive to any break of the alarm loop; and

a retracting mechanism in said housing continuously urging the cable first end toward the housing yet allowing the cable first end to be pulled away from the housing when an external force is exerted on the cable first end.

b. No claims recite the following combination of elements including the elements stated in subparagraph a. hereof wherein:

the retracting mechanism continuously urges the cable first end toward the housing, and whereby a user can grasp and pull on a product attached to the cable first end to place the product in a comfortable position with a minimum amount of cable extending from said housing.

c. No claims recite the following combination of elements including the elements stated in subparagraphs a. and b. hereof, where the recited retracting mechanism comprises:

a pulley mounted for free rotation relative to said housing and including a sensor hub and an alarm system hub

separated by a disk, said disk having a
hole therein, whereby said cable ex-
tends from said cable first end into said
housing where it winds around said
sensor hub then extends through said
pulley disk hole and winds about said
alarm system hub then extends from
said housing to said cable second end;
and
a spring continuously biasing said pulley toward winding
said cable onto said sensor hub.

d. Claims 12-14 added with this reissue application correct this error by adding claims of this appropriate scope as further set forth below.

11. With respect to the error specified in paragraphs 8 and 9 of this Declaration:

a. Upon information and belief, this error arose due to a failure of the undersigned to appreciate and communicate certain prior art to the assignee's prosecuting attorney. Specifically, the undersigned were at the time of their invention aware of cable retraction devices

used in connection with telephones. Such devices were different from the undersigned's invention because they did not in any way relate to security systems or alarms and had no sensor for detecting whether a product is connected to the cable. However, during prosecution of the application resulting in the '771 patent, a new claim was added (ultimately issuing as claim 11) in which the sensor was not recited as an element. The undersigned did not then appreciate that the new claim presented a scope of claim coverage which did not in some manner positively require an alarm system or sensor, and therefore the undersigned did not then recognize that the telephone cable retracting devices were material prior art to the invention as recited in that new claim.

b. This error continued to go uncorrected until the filing of this reissue application because no one's attention was drawn to this point until shortly before such filing for reissue when the '771 patent and its prosecution history were reviewed by the inventors and the assignee's attorney in connection with their analysis of the patent regarding a potential infringement of the '771 patent. The undersigned understood at that time that the potential infringer was a manufacturer of a telephone cable retraction device for GTE Airfone. Therefore, during the course of continuing analysis by the undersigned preparatory to potential litigation, the undersigned searched on the Internet for GTE

Airfone patents and, as a result of that search, found and obtained a copy of U.S. Patent No. 5,535,960. The undersigned then brought this matter to the attention of the assignee's attorney who, in order to be complete, also obtained copies of the references cited in the GTE Airfone '960 patent, including U.S. Patent Nos. 4,989,805 and 5,094,396, and copies of all of those references are submitted herewith in an Information Disclosure Statement.

12. With respect to the error specified in paragraphs 8 and 10 of this Declaration:

a. Upon information and belief, this error also arose due to a failure of the undersigned to appreciate and communicate certain prior art to the assignee's prosecuting attorney. Specifically, as noted above, the undersigned were at the time of their invention aware of telephone cable retraction devices. Such devices are different from the undersigned's invention because they do not in any way relate to security systems or alarms and had no sensor for detecting whether a product is connected to the cable. Therefore, the undersigned did not recognize those telephone devices to be relevant to their invention.

b. This error continued to go uncorrected until the filing of this reissue application because no one's attention was drawn to this point until shortly before such filing for reissue when the '771 patent

and its prosecution history were reviewed by the inventors and the assignee's attorney in connection with their analysis of the patent regarding a potential infringement of the '771 patent. During the course of that detailed analysis preparatory to potential litigation:

1. The undersigned searched for and found a GTE Airfone patent (U.S. Patent No. 5,535,960) disclosing a prior art telephone cable retracting device as previously noted herein. In order to be complete, copies of the references cited in the GTE Airfone '960 patent were obtained, including U.S. Patent Nos. 4,989,805 and 5,094,396, and copies of all of those references are submitted herewith in an Information Disclosure Statement. Analysis that new prior art and the prosecution history of the application resulting in the '771 patent showed that arguments were made during the prosecution of the application issuing as the '771 patent which, though true and correct in distinguishing the claims from the prior art then being discussed, would not have been accurate had the additional prior art submitted herewith, particularly U.S. Patent Nos. 4,989,805, 5,094,396, 5,535,960, been of record. As a result of the misdirected focus regarding the prior art during the prosecution of the application issuing as the '771 patent, the undersigned and, upon information

and belief, the prosecuting attorney failed to recognize that the claims as presented in the application resulting in the '771 patent did not properly claim the full scope of the undersigned's invention because the claims as issued in the '771 patent were prosecuted to distinguish prior art which did not include the additional prior art submitted herewith.

2. Discovery of the error in claim 11 and discussed in this Declaration in paragraphs 5, 6 and 7 (relating to the imprecise recitation of a "secured state" resulting from a "continuous electrical path between cable ends") caused the undersigned and, upon information and belief, the assignee's attorney, to recognize that the fundamental structure of the sensor which is an important element of the combination of applicants' invention (namely, the circuit loop from the second cable end to the first cable end and back to the second cable end, and the breaking of that loop if a product is disconnected from the first cable end) was unnecessarily narrowly claimed in the claims issued in the '771 patent. Discovery of the error in claim 11 and discussed in this Declaration in paragraphs 8 and 9 (relating to the overbreadth of claim 11 in failing to recite anything relating to the sensor on the first cable end) caused the

undersigned and, upon information and belief, the assignee's attorney, to further recognize that the inventive combination would most appropriately and broadly include "means for electrically connecting" cable conductors to "form an alarm loop" (as recited in claims 12-14 submitted herewith) without unnecessarily limiting the claims to a "sensor" per se.

3. Discovery of the new prior art submitted herewith and previously noted herein relating essentially to the retraction of a cable caused the undersigned and, upon information and belief, the assignee's attorney, to recognize that yet another element of the preferred form of the present invention and distinguishing from the closest prior art among that cited herein (namely, U.S. Patent Nos. 4,989,805, 5,094,396, 5,535,960) has not been included in the claims issued in the '771 patent, namely, that the retracting mechanism continuously urges ← the cable first end toward the housing (as variously recited in new claims 12-14 submitted herewith). U.S. Patent Nos. 4,989,805, 5,094,396, 5,535,960 all use ratchet structures to prevent the continuous urging of their cord ends toward retraction, and thus would not provide the ideal operating characteristics of the present invention. The '771 patent erroneously failed to recite

this element ("continuous" urging) in at least one claim this aspect (continuous urging").

13. The above specified errors arose without any deceptive invention on the part of the applicant.

We further state that all statements made herein of our knowledge are true and that all statements made on information and belief are believed to be true; and further that the statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful statements may jeopardize the validity of the application or any reissue patent issuing thereon.

2/13/97
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2-13-97
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